

**PETITION UNDER 37 C.F.R. § 1.181  
EXPEDITED PROCEDURE  
EXAMINING GROUP 2600**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named	
Inventor :	Joel R. Weiss et al.
Appln. No.:	10/734,377
Filed :	December 12, 2003
For :	MINIMIZED SKEW ANGLE SLIDER
Docket No.:	S01.12-1009
	Group Art Unit: 2627
	Examiner: Allen T. Cao

**PETITION UNDER 37 C.F.R. 1.181**  
**TO VACATE FINAL STATUS OF OFFICE ACTION AS PREMATURE**

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**ELECTRONICALLY FILED**  
**August 22, 2008**

Sir:

This petition is in response to the Office action dated May 28, 2008 and the advisory action dated August 21, 2008. The applicants respectfully petition the Director under 37 C.F.R. 1.181, through the Technology Center Director as the official with delegated authority, to review and vacate the final rejection status of the present application as premature.

**Background**

This petition is filed in parallel to a pending petition under 37 CFR 1.144, filed by the applicants on July 28, 2008, to reverse the restriction requirement as relied on in the Office action of May 28, 2008. The need for and timing of both petitions is made clear in the following remarks.

37 C.F.R. 1.104(b) requires an examiner to make an Office action complete as to all matters, with rare exceptions where appropriate in cases such as misjoinder of invention, fundamental defects in the application, or mere formalities.

In the latest Office action on the present application, dated May 28, the examiner repeated a rejection of all claims and made the action final, based on the assertion that the claim amendments made in the applicants' prior response of March 4, 2008 constituted a shifting to non-elected subject matter and would not be considered, and with a repetition of the arguments for rejection from the prior Office action, dated December 4, 2007, as applied to the claims before their amendments in the applicants' March 4 response.

In a subsequent response dated July 28, 2008, the applicants pointed out that the prior claim amendments constituted a proper amendment within the scope of the elected subject matter and did not constitute a shifting to non-elected subject matter, and requested that the examiner reconsider and withdraw the final status of the Office action.

37 C.F.R. 1.181(c) provides in part that when a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (37 C.F.R. 1.111) and a repeated action by the examiner. The applicants submit that their remarks in their response of July 28 include a proper request for reconsideration for the purposes of §181(c), and were explicitly identified as such in the applicants' response; and that the issuance of the advisory action of August 21 constitutes a repeated action by the examiner to adhere to the final status of the Office action of May 28 and a new unfavorable action from which the applicants may petition for relief. The applicants therefore submit that the conditions for this petition under §181(c) are satisfied. Since the advisory action of August 21 is the action from which relief is requested, the period for filing a petition from it under 37 C.F.R. 1.181(f) is through October 21, and this petition is timely filed.

The Technology Center Director is the official with authority delegated by the Director to consider this petition (see MPEP 1002.02(c)(3)(a)).

**Remarks: The final rejection was premature and should be vacated**

The Office action of May 28 made the rejection of all pending claims final based on the rationale that the prior claim amendments constituted a shift to non-elected subject matter. However, as the applicants pointed out in their response of July 28, the amendments only further

narrowed the existing claims, and did not remove any elements of the claims, and this could not have constituted a shift to non-elected subject matter as opposed to a proper narrowing of the elected subject matter.

The final rejection of all pending claims in the Office action of May 28 was based on arguments that applied to the applicants' claims prior to their amendment in the applicants' March 4 response, and ignoring the pending claims as amended, based on the argument that the amendments would not be considered because they constituted a shift to non-elected subject matter. Because the decision that the amended claims constitute non-elected subject matter was not correct, the basis for not examining the claims as amended was also not correct, and the action was not properly complete, since it did not include any examination of the claims as amended. Therefore, the final rejection was premature, and should be vacated.

**Narrowing a claim does not constitute shifting to non-elected subject matter**

The basis of this argument that the final rejection was premature is that the claim amendments did not constitute a shifting to non-elected subject matter. Where a set of claims have been subject to a prior restriction requirement and corresponding election, a shifting to non-elected subject matter would require a claim to be amended both to eliminate one or more elements defining the elected subject matter, as well as adding one or more elements defining the non-elected subject matter. In the present case, the applicants did not eliminate any elements from the claims in amending them, but only added additional elements (and in one case, rearranged existing elements). Each of the amended claims therefore still retains every defining element of the elected subject matter.

The examiner relies on the contrary argument that amending a claim to add any element that is construed to coincide with a non-elected embodiment constitutes a shifting to the non-elected embodiment, despite the fact that, because the claim also still retains all of its prior elements, it must also still belong to the elected subject matter. By that logic, if the other subject matter had been elected and then the claim amended to add an element from the first subject matter, it would also constitute an impermissible shifting. A claim amended to contain individual

elements that might be construed to coincide with two embodiments identified in the restriction requirement would therefore become a “shifting” and out-of-bounds for examination regardless of which embodiment had been elected. This would transform the restriction requirement into an excessively burdensome obstacle to amending claims and to successfully prosecuting an application. The addition of further elements alone to a claim does not constitute a shifting away from an elected embodiment.

Furthermore, in this particular case, the examiner posed not just one, but a series of restriction requirements that were so intricate as to define a great number of individual details, even within the same embodiment, as supposedly defining characteristics of multiple restricted embodiments. Accordingly, the applicants previously filed a petition under 37 CFR 1.144 on July 28, currently pending, to reverse the restriction requirement as relied on in the Office action of May 28. The many distinctions listed in the restriction requirements are so hyperfine as to encompass a substantial proportion of the possible elements that might be added to the claims by amendment that would be properly supported by the specification. If amending a claim merely to add any element listed in a non-elected embodiment, as opposed to shifting to that non-elected embodiment, were accepted as a shifting to non-elected subject matter, combined with the hyperfine details taken to define the different restricted embodiments, this would effectively foreclose the applicants from making a substantial proportion of potential claim amendments. Taken to its logical endpoint, such a method of examination could allege any claim amendments at all as constituting a shifting to some element of an extensive and hyperfine catalog of supposedly restricted embodiments, thereby foreclosing the possibility of any claim amendments at all. This does not comply with the proper practice under restriction requirements, and would pose an excessive burden to the Office’s and applicants’ goal of successfully prosecuted patent applications.

Additional details of the claims and their amendments, in support of the remarks above, are provided as follows.

**Amended claims 1 and 27 are not drawn to non-elected subject matter**

The Office action of May 28, 2008 (hereinafter “the Office action”) indicates that the subject matter added by amendment to claims 1 and 27 in the applicants’ response of March 4, 2008 (hereinafter “the prior response”) was disregarded for purposes of the Office action, as being directed to non-elected subject matter. The applicants respectfully submit that the subject matter of claims 1 and 27 as amended in the prior response is directed to subject matter that did not, in its entirety, appear in any previous claims, non-elected or otherwise, and therefore could not be drawn to a non-elected species.

The Office action indicates that the subject matter newly added to claims 1 and 27 is included in the non-elected species claims 15 and 16. However, only a portion of the newly added subject matter is actually recited in claims 15 and 16, while the totality of the newly added subject matter is not included in claims 15 and 16, or in any of the prior claims.

Specifically, claim 1 was amended in the prior response as follows, with markings reproduced to show the amended subject matter:

1. A suspension assembly comprising a suspension, a slider, and a suspension interface comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket, wherein the suspension interface that provides substantial freedom of rotation of the slider about a yaw axis relative to the suspension.

Claim 27 was amended in the prior response as follows, with markings reproduced to show the amended subject matter:

27. (Currently amended) A slider, comprising:

means for operatively suspending the slider from a suspension, the means comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket, wherein the means provides substantial freedom of rotation of the slider about a yaw axis; and

means for exploiting an ambient fluid flow ~~to provide substantial freedom of rotation of the slider about a yaw axis~~ to reduce a skew angle of the slider relative to the ambient fluid flow.

On the other hand, claims 15 and 16 read as follows:

15. The suspension assembly of claim 1, wherein the suspension interface comprises a pivot.
16. The suspension assembly of claim 1, wherein the suspension interface comprises a pivot socket.

Claim 15 therefore further limits claim 1 only to the extent of reciting that the suspension interface comprises a pivot, and claim 16 further limits claim 1 only to the extent of reciting that the suspension interface comprises a pivot socket. Withdrawn claim 35 recites certain analogous subject matter, but is dependent on a different parent claim, and also does not recite wherein the pivot is rotatably engaged with the pivot socket. On the other hand, claims 1 and 27 as amended also recite wherein the pivot is rotatably engaged with the pivot socket. This subject matter did not appear in any claim prior to the amendment of the prior response. Since it did not appear in any claim, it certainly did not appear in any previously non-elected claim.

Furthermore, when the restriction requirement was made, the Office indicated that claims 1 and 27 were among the claims that were generic to all indicated species (Office action of August 7, 2006, page 2, paragraph 3). The applicants submit that the Office was correct in that assessment, and that the amendments of claims 1 and 27 only further define the elected species within the scope of those originally generic claims.

**Restriction of claims is improper because adding further limitations to a claimed species does not constitute a shift to a different, independent species**

The applicants further submit that even if the subject matter newly added by amendment in the prior response had been limited to that of other, non-elected claims, its combination with

the other subject matter of claims 1 and 27 without any subject matter being removed from claims 1 and 27 constitutes an acceptable further narrowing of the elected subject matter, not a shift to non-elected subject matter, since claims 1 and 27 are still directed to all the limitations of the elected subject matter in its original form, in addition to the narrowing amendments. (The applicants note that while some wording was struck in the amendment to claim 27, this wording was only rearranged rather than removed from the claim.) The applicants therefore respectfully submit that claims 1 and 27 as amended do not constitute independent and distinct inventions from the elected species.

While the Office action refers to 37 C.F.R. 1.142(b) and MPEP 821.03, the rule indicated therein provides only that an applicant may not shift from elected subject matter to non-elected subject matter, not that an applicant is barred from later narrowing the elected subject matter with a narrowing amendment that has any overlap with the non-elected subject matter. Rather, the opposite is the case, as MPEP 821.03 explicitly provides that “[t]he practice set forth in this section is not applicable... where applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.” Since the amendments to claims 1 and 27 only add further limitations to their subject matter, they do not give rise to independent and distinct inventions, and could not properly have been restricted from the original claims 1 and 27 if they had been presented earlier.

The Office action reasons that the newly amended claims are independent “or” distinct from the originally claimed invention. The applicants respectfully point out that restriction is only proper in the case of species that are both independent “and” distinct (37 C.F.R. 1.142(a)), and the Office action has explicitly applied an incorrect standard for evaluating whether restriction would be proper for claims 1 and 27 as amended. The applicants further submit that a claim that is amended only to add further limitations that narrow its scope, rather than an amendment that eliminates some elements in exchange for others, by definition is not “independent” from the original form of that claim.

As defined by the restriction requirement, the defining elements of the elected species are directed to features associated with the air bearing surface of a slider, and the defining elements

of the species of claims 14 and 15 are directed to features associated with the back surface of a slider. The differences used to try to define separate species are therefore no more than different perspective views of the same subject matter, for purposes of claims 1 and 27 in light of the previous election and amendments. Two perspective views of the same device from two different directions do not constitute two independent and distinct inventions.

The applicants therefore respectfully submit that claims 1 and 27 as amended are not directed to a new species because they are not independent from the subject matter already examined on the merits.

**Conclusion: The final rejection was premature and should be vacated**

The applicants therefore respectfully request that the Director review and vacate the final rejection of the Office action of May 28, 2008 in the present application, and remand to the examiner with instructions to examine the claims as amended in light of the amendments and arguments in the applicants' response of March 4 and in light of instructions that the claim amendments in the applicants' response of March 4 are proper.

The Director is authorized to charge any fee deficiency required by this paper or any paper in the prosecution of this application or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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